

## **REMARKS**

Applicant respectfully requests reconsideration and allowance of the subject application. Claims 1-13 and 34-35 are canceled without prejudice. Claims 14-33 and 36-53 are pending in this application.

### **35 U.S.C. § 112**

Claims 14-33 stand rejected under 35 U.S.C. §112, second paragraph. As part of this response, claims 14 and 24 have been amended to correct the antecedent basis issues identified in the January 30 Office Action. Accordingly, Applicant respectfully submits that claims 14-33 comply with 35 U.S.C. §112, second paragraph, and respectfully requests that the §112 rejections be withdrawn.

### **35 U.S.C. § 103**

Claims 14-33 and 36-53 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,393,430 to Van Ryzin (hereinafter “Van Ryzin”) in view of U.S. Patent Application Publication No. 2003/0227473 to Shih et al. (hereinafter “Shih”). Applicant respectfully submits that claims 14-33 and 36-53 are not obvious over Van Ryzin in view of Shih.

As discussed in the Abstract of Van Ryzin, Van Ryzin is directed to a method and system for the creation of a custom playlist of various audio/visual tracks that are to be automatically recorded to a storage medium. The user communicates with personal computer (PC) software by means of a graphical user interface (GUI). The GUI allows the user to create a custom playlist and to signal the intent that a recording of that custom playlist to a storage medium be made.

Once the user has indicated the custom playlist is to be recorded, the software automatically records the custom playlist with no further user interaction required.

As discussed in the Abstract of Shih, Shih is directed to a computer method and system for incorporating user-personalized music and/or sound into a video game. In part, the invention relates to a music engine that interfaces with a video game, and provides a plurality of user-personalized sound files to the video game. The invention also relates to an encoded tag text files that identifies a user-personalized sound file to be played back at a specific point in a program.

As discussed at MPEP §§ 2142 and 2143, to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Applicant respectfully submits that there is no suggestion or motivation to combine Van Ryzin and Shih, and thus that no *prima facie* case of obviousness has been established. Van Ryzin, as discussed above, is directed to how songs are copied to a personal computer, whereas Shih is directed to incorporating music and/or sound into a video game. These references are directed to two different problems or technologies. As such, there is no suggestion or motivation, either in

the references themselves or in the knowledge generally available to one of ordinary skill in the art, to combine the teachings of these two references.

As discussed in MPEP §2143.01(III), the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. Accordingly, Applicant respectfully submits that the mere fact that Van Ryzin and Shih can be combined does not render the resultant combination obvious because the prior art does not suggest the desirability of the combination.

Accordingly, Applicant respectfully submits that claims 14-33 and 36-53 are not obvious over Van Ryzin in view of Shih at least because a *prima facie* case of obviousness has not been established.

Applicant respectfully requests that the §103 rejections be withdrawn.

### **Conclusion**

All of the claims are in condition for allowance. Accordingly, Applicant requests that the Office issue a Notice of Allowability. If the Office's next anticipated action is to be anything other than issuance of a Notice of Allowability, Applicant respectfully requests a telephone call for the purpose of scheduling an interview.

Respectfully Submitted,

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